

## REMARKS

Applicants appreciate the indication that claims 39, 41, 57-58, and 60 recite allowable subject matter.

Applicants hereby add new claims 61-65. Accordingly, claims 36-38, 40-42 and 53-65 are pending in the present application.

Claims 36, 40, 42, and 59 stand rejected under 35 U.S.C. 102(e) for anticipation by U.S. Patent No. 6,048,256 to Obeng et al. Claims 36-38, 40, 42, and 59 stand rejected under 35 U.S.C. 102(b) for anticipation over U.S. Patent Nos. 5,755,914 and 5,664,990 to Adams et al. Claims 53-56 stand rejected under 35 U.S.C. 103(a) for obviousness over Adams in view of U.S. Patent No. 5,923,433 to Giuffre et al.

Applicants respectfully traverse the rejections and urge allowance of the present application.

Claim 36 includes the limitations of previously pending claim 39. Claim 36 is believed to be allowable in view of the indication in the Office Action that claim 39 recites allowable subject matter.

The claims which depend from independent claim 36 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Claim 53 stands rejected under 103 over Adams and Giuffre. Page 4 of the Office Action provides a recitation of components of the sensor of Giuffre. Thereafter, on page 5 of the Office Action, it is stated that it would have been obvious to modify the system of Adams when utilizing a turbidity sensor by providing a turbidity sensor such as Giuffre which utilizes electromagnetic energy in order to monitor physical properties of fluid flowing

therethrough with a low cost sensor. Applicants submit the Office Action fails to establish a proper *prima facie* 103 rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143.(8<sup>th</sup> ed.).

The Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The motivation identified in the Office Action is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite motivation to support an obviousness rejection. The Court in *In re Lee* stated the factual inquiry whether to combine references must be through and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.

In the instant case, the record is entirely devoid of any evidence to support motivation to combine the teachings apart from the bald conclusory statements of the Examiner which are insufficient for proper motivation as set forth by the Federal Circuit. The Office cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims but must set forth rationale on which it relied. Statements set forth in the present Office Action are akin to the alleged motivation discussed *In re Lee* and accordingly are insufficient to combine the reference teachings.

In particular, the only motivation recited in the Office Action is to monitor physical properties "with a low cost sensor." Such statements generally regarding cost are conclusory and in accordance with *In re Lee*, insufficient for a proper 103 rejection. Initially, col. 1, lines 15-55 of Giuffre are directed towards prior art arrangements which utilize a quartz glass media tube which is expensive as set forth in col. 1, line 37. Accordingly, the **statements in Giuffre with respect to cost are only relative to the prior art device discussed in col. 1, lines 20-55 utilizing the quartz glass media tube.** Motivating one to look to the structure of Giuffre over the specific device discussed in col. 1 of Giuffre is insufficient to establish motivation to modify the teachings of Adams in the first instance. But for improper reliance upon Applicants' disclosure, the Office has failed to provide an impetus of why one of ordinary skill in the art would desire to modify the teachings of Adams. The "low cost" teachings of Giuffre are only with respect to the prior art device discussed in the background of Giuffre and fail to provide any motivation to modify the teachings of Adams in the first instance. Indeed, there are no teachings that Adams uses a quartz glass media tube to motivate one to look to Giuffre for meaningful teachings.

Applicants submit there is no motivation to modify the teachings of Adams as required by a proper 103 rejection. The motivation for forming the combination must be something other than hindsight reconstruction based on using Applicant's invention as a road map for such a combination. See, e.g., *Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990).

The 103 rejection of claim 53 is improper without the proper motivation and Applicants respectfully request allowance of claim 53 in the next action.

The claims which depend from independent claim 53 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

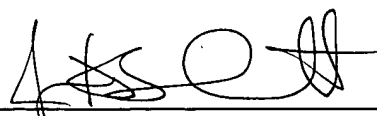
Applicants hereby add new claims 61-65. Claim 61 includes the limitations of claims 36 and 41 and is believed to be allowable inasmuch as claim 41 was indicated to be allowable in the Action. Claim 62 includes the limitations of claims 36 and 60 and is believed to be allowable inasmuch as claim 60 was indicated to be allowable in the Action. Support for new claims 63-65 is provided at least at Figs. 1 and 3 and the associated specification teachings of the originally filed application.

Applicants request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

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